

#13
MB
05/30/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

In re application of:

GERARD *et al.*

Appl. No.: 09/245,025

Filed: February 5, 1999

For: **Compositions and Methods for
Reverse Transcription of Nucleic
Acid Molecules**

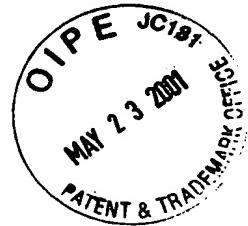
MAY 25 2001

TECH CENTER 1600/2900

Art Unit: 1652

Examiner: Tung, P.

Atty. Docket: 0942.4330003/RWE/BJD



**Reply to Notice to Comply with Requirements for
Patent Applications Containing Nucleotide Sequence and/or
Amino Acid Sequence Disclosures**

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Notice dated April 24, 2001 (Paper No. 12), requiring submission of a computer readable form of the Sequence Listing in the above-referenced patent application, Applicants hereby submit a copy of the PTO date-stamped postcard evidencing the filing of a Request to Open New Disk File concurrently with the captioned application on February 5, 1999, and resubmit a copy of the Utility Patent Application Transmittal, and the Request to Open New Disk File.

Applicants believe that the Notice was issued in error, and that the documents submitted herewith clearly evidence this oversight by the U.S. Patent and Trademark Office. Therefore, reconsideration and withdrawal of the Notice is respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are

GERARD *et al.*

- 2 -

Appl. No. 09/245,025

necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036. A duplicate copy of this Reply is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

Date: May 23, 2001

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005
(202) 371-2600

P:\USERS\BRIAND\0942\4330003\05212001,reply to seq req.wpd

COPY

Due Date: N/A

Applicant: GERARD *et al.*

Art Unit: To be assigned

Examiner: To be assigned

Docket: 0942-330003 FEB 5 - 1999

Atty: RWE/BDE

Application No.: To be assigned (Divisional of U.S. Appl.
No. 09/064,057)

Filed: Herewith

For: Compositions and Methods for Reverse Transcription of Nucleic Acid Molecules

When receipt stamp is placed hereon, the USPTO acknowledges receipt of the following documents:

1. Utility Patent Application Transmittal (Form PTO/SB/05); 2. Fee Transmittal (Form PTO/SB/17) (*in duplicate*); 3. U.S. Divisional Patent Application entitled: **Compositions and Methods for Reverse Transcription of Nucleic Acid Molecules** and naming as inventors: Gary F. GERARD, Michael D. SMITH and Deb K. CHATTERJEE, the application consisting of: a. A specification containing: (i) 116 pages of description prior to the claims, including a sequence listing at pages 108-116; (ii) 16 pages of claims (115 claims); (iii) a one (1) page abstract; (iv) 54 sheets of drawings: (Figures 1-54); 4. Copy of the Declaration for Patent Application, executed by the inventors in the parent application; 5. Preliminary Amendment; 6. Authorization To Treat A Reply As Incorporating An Extension Of Time Under 37 C.F.R. § 1.136(a)(3) (*in duplicate*); 7. Request to Open New Disk File; 8. Our Check No. 23597 in the amount of \$1,120.00, to cover: \$760.00 utility filing fee; \$126.00 fee for excess total claims; and \$234.00 fee for excess independent claims; and 9. Two (2) return postcards.

PLEASE AFFIX RECEIPT DATE STAMP AND RETURN POSTCARD TO OUR COURIER

Box: Patent Application

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.	
UTILITY PATENT APPLICATION TRANSMITTAL <i>(Only for new nonprovisional applications under 37 CFR § 1.53(b))</i>	
ATTORNEY DOCKET NO. 0942.4330003/RWE/BJD First Inventor or Application Identifier GERARD Title Compositions and Methods for Reverse Transcription of Nucleic Acid Molecules Express Mail Label No.	

APPLICATION ELEMENTS <i>See MPEP chapter 600 concerning utility patent application contents.</i>		ADDRESS TO: Assistant Commissioner for Patents Box Patent Application Washington, DC 20231
<p>1. <input checked="" type="checkbox"/> * Fee Transmittal Form (e.g., PTO/SB/17) <i>(Submit an original, and a duplicate for fee processing)</i></p> <p>2. <input checked="" type="checkbox"/> Specification [Total Pages 133] <i>(preferred arrangement set forth below)</i> - Descriptive title of the Invention - Cross References to Related Applications - Statement Regarding Fed sponsored R & D - Reference to Microfiche Appendix - Background of the Invention - Brief Summary of the Invention - Brief Description of the Drawings (<i>if filed</i>) - Detailed Description - Claim(s) - Abstract of the Disclosure</p> <p>3. <input checked="" type="checkbox"/> Drawing(s) (35 U.S.C. 113) [Total Sheets 34]</p> <p>4. <input checked="" type="checkbox"/> Oath or Declaration [Total Pages 2]</p> <p>a. <input type="checkbox"/> Newly executed (original or copy)</p> <p>b. <input checked="" type="checkbox"/> Copy from a prior application (37 CFR 1.63(d)) (<i>for continuation/divisional with Box 17 completed</i>) <i>[Note Box 5 below]</i></p> <p>i. <input type="checkbox"/> DELETION OF INVENTOR(S) Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR §§ 1.63(d)(2) and 1.33(b).</p> <p>5. <input checked="" type="checkbox"/> Incorporation By Reference (<i>useable if Box 4b is checked</i>) The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.</p> <p>17. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment:</p> <p><input type="checkbox"/> Continuation <input checked="" type="checkbox"/> Divisional <input type="checkbox"/> Continuation-in-Part (CIP) of prior application No: <u>09/064,057</u></p> <p>Prior application information: Examiner <u>Whisenant, E.</u> Group/Art Unit: <u>1634</u></p>		
<p>6. <input type="checkbox"/> Microfiche Computer Program (<i>Appendix</i>)</p> <p>7. Nucleotide and/or Amino Acid Sequence Submission (<i>if applicable, all necessary</i>)</p> <p>a. <input type="checkbox"/> Computer Readable Copy</p> <p>b. <input checked="" type="checkbox"/> Paper Copy (<i>identical to computer copy</i>)</p> <p>c. <input type="checkbox"/> Statement verifying identity of above copies</p>		
<p>ACCOMPANYING APPLICATION PARTS</p> <p>8. <input type="checkbox"/> Assignment Papers (cover sheet & document(s))</p> <p>9. <input type="checkbox"/> 37 CFR 3.73(b) Statement <input type="checkbox"/> Power of Attorney <i>(when there is an assignee)</i></p> <p>10. <input type="checkbox"/> English Translation Document (<i>if applicable</i>)</p> <p>11. <input type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <input type="checkbox"/> Copies of IDS Citations</p> <p>12. <input checked="" type="checkbox"/> Preliminary Amendment</p> <p>13. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) <i>(Should be specifically itemized)</i></p> <p>14. <input type="checkbox"/> *Small Entity Statement(s) <input type="checkbox"/> Statement filed in prior application, Status still proper and desired <i>(PTO/SB/09-12)</i></p> <p>15. <input type="checkbox"/> Certified Copy of Priority Document(s) <i>(if foreign priority is claimed)</i></p> <p>16. <input checked="" type="checkbox"/> Other: 37 C.F.R. § 1.136(a)(3) Authorization <input checked="" type="checkbox"/> Other: Request to Open New Disk File</p> <p>*NOTE FOR ITEMS 1 & 14: IN ORDER TO BE ENTITLED TO PAY SMALL ENTITY FEES, A SMALL ENTITY STATEMENT IS REQUIRED (37 C.F.R. § 1.37), EXCEPT IF ONE FILED IN A PRIOR APPLICATION IS RELIED UPON (37 C.F.R. § 1.28).</p>		

18. CORRESPONDENCE ADDRESS

<input type="checkbox"/> Customer Number or Bar Code Label (Insert Customer No. or Attach bar code label here)		<i>or</i> <input checked="" type="checkbox"/> Correspondence address below	
NAME	STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. Attorneys at Law		
ADDRESS	Suite 600, 1100 New York Avenue, N.W.		
CITY	Washington	STATE	DC
COUNTRY	USA	TELEPHONE	(202) 371-2600
ZIP CODE	20005-3934		
FAX	(202) 371-2540		

NAME (Print/Type)	Brian J. Del Buono	Registration No. (Attorney/Agent)	42,473
SIGNATURE	<u>Brian J. Del Buono</u>	Date	February 5, 1999

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

GERARD et al.

Appl. No. (To be assigned; Divisional of
U.S. Appl. No. 09/064,057)

Filed: (Herewith)

For: **Compositions and Methods for
Reverse Transcription of Nucleic
Acid Molecules**

Art Unit: (To be assigned)

Examiner: (To be assigned)

Atty. Docket: 0942.4330003/RWE/BJD

Request to Open New Disk File

O I P E SC13
MAY 23 2001
PATENT & TRADEMARK OFFICE
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:
Applicants request that a new disk file be opened for the above-cited application. The Sequence Listing disk submitted on April 22, 1998, in the parent, U.S. Application No. 09/064,057, filed April 22, 1998, contains the identical sequence information as that in the present application.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
Agent for Applicants
Registration No. 42,473

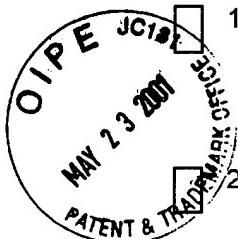
Date: February 5, 1999

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):



1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
6. The paper copy of the "Sequence Listing" is not the same as the computer readable from of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
7. Other: _____

Applicant Must Provide:

- An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

PatentIn Software Program Support

Technical Assistance.....703-287-0200

To Purchase PatentIn Software.....703-306-2600

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR REPLY